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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,837	03/26/2004	Blayn W. Beenau	70655.0200	2836

20322 7590 03/22/2006

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EXAMINER	
WALSH, DANIEL I	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/708,837	BEENAU ET AL.	
	Examiner	Art Unit	
	Daniel I. Walsh	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3, 4, &8-04, 11-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 1 July 2005 and 5 August 2005.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. Claims 1, 6, and 13 is objected to because of the following informalities:

Re claim 1: Replace "a reader configured" with -- said reader configured --.

Re claim 6: Replace "claim 4" with – claim 5 --.

Re claim 13: Replace "biometric sample is primarily" with – first biometric sample is primarily --, and "biometric sample is secondarily – with – second biometric sample is secondarily --.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not

identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 10/710,330. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn towards contactless communication of data. Though the current application is drawn towards a transponder-reader system and the '330 Applicant is drawn to a smartcard system, both types of media are recognized as obvious and conventional types of media for communicating. Therefore, such modification is well within the skill in the art, especially as prior art discloses transponders and smart cards being interchangeable, for design choice, system constraints, cost, convenience, etc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

I) For example, in claim 1 of the present Patent Application the Applicants claim: "... transponder... reader... first proffered...second proffered...facilitate a transaction."

(see claim 1), whereas in the '330 Patent Application the Applicants claim: "... smartcard... reader... first proffered...second proffered...facilitate a transaction." (see claim 1).

II) For example, in claim 18 of the present Patent Application the Applicants claim: "...transponder... first biometric...second biometric...communicating with said system." (see claim 18), whereas in the '330 Patent Application the Applicants claim: "... smartcard... first biometric...second biometric...communicating with said system." (see claim 18).

III) For example, in claim 27 of the present Patent Application the Applicants claim: "... transponder... first proffered...second proffered...authorizing..." (see claim 27), whereas in the '330 Patent Application the Applicants claim: "...smartcard... first proffered...second proffered...authorizing..." (see claim 27).

5. Additionally, the Examiner notes that claims 1, 18, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 of copending Application No. 10/708,824 and 10/708,829, claim 8 of 10/708823, claims 33 and 41 of 10/710,329, 10/710,328, 10/710,326, 10/710,315, 10/710,311, 10/708,826, 10/708,825, 10/708,836, 10/708,835, 10/708,833, and 10/708,827, claims 32 and 40 of 10,710,327, 10/710,325, 10/710,324, 10/710,323, 10/710,317, 10/708,830, 10/708,832, 10/708,834, and 10/708,831. Though not identical, the Examiner notes that the above Applications recite specific types of biometrics, well known in the art for alternative means to identify an individual, and that the smartcard/transponder systems have been discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 8, 10-12, 16-22, 24, and 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Black (US 2005/0122209). Re the pending claims, the Examiner notes that Black teaches a transponder can be a smartcard (paragraph [0014]) for example.

Re claim 1, Black teaches a transponder configured to communicate with a reader, a reader configured to communicate with the system, a biometric sensor configured to detect a first proffered biometric sample (signature) and a second proffered biometric sample (fingerprint), the sensor configured to communicate with the system, and a device configured to verify the samples facilitate a transaction (abstract and FIG. 1A).

Re claim 2, the sensor is configured to communicate with the system via at least one of a transponder, reader, and network (FIG. 1A).

Re claim 3, the signature scan sensor is configured to facilitate a finite number of scans (to obtain the samples).

Re claim 4 and 39, Black teaches the sensor is configured to log at least one of detected scan samples, processed scan samples, and stored scan samples (FIG. 5A+,

paragraph [0125], and FIG. 10A+). A transaction record of the samples is interpreted as logging.

Re claim 8, the proffered sample is compared to a stored sample to verify the signatures/biometric, as discussed above.

Re claim 10, as the sample is stored, its interpreted as registered.

Re claim 11, Black teaches that a customer's account is linked to the biometric/signature data and can be used for payment and is linked to a credit or debit account (col 6, lines 46+ and abstract).

Re claim 12, the system of Black can be used by numerous individuals, who inherently have different information. Therefore Black is believed to teach different samples (different people) and therefore different accounts/information being associated.

Re claim 16, it has been discussed above that the device facilitates a financial transaction.

Re claims 17 and 26, the Examiner notes that such procedures (PIN, codes, passwords, etc) are all well known and conventional in the art for increased security. The Examiner notes that Black teaches the capture of biometrics, metrics, and signatures (FIG 1A), which is interpreted as a secondary security procedure from the two samples, used in the verification process.

Re claim 18, the limitations have been discussed above (abstract, FIG. 1A, and as discussed above).

Re claim 19, the Examiner has interpreted the storing of the signature scan sample and biometric as two biometric sample being registered with an authorized sample receiver (the system).

Re claim 20, the Examiner notes that registering includes proffering the same (abstract, FIG. 5A, as discussed above).

Re claim 21, the Examiner has interpreted the registering to include proffering a second biometric to the authorized sample receiver, as discussed above, as part of the authentication process.

Re claim 22, the Examiner notes that proffering includes initiating at least one of storing, comparing, and verifying the sample, as discussed above.

Re claim 24, it has been discussed above that a proffered sample is compared with a stored sample.

Re claim 27, the limitations have been discussed above.

Re claim 28, Black teaches that the samples are detected at least at one of a transponder/reader/network (FIG. 1A-1C).

Re claim 29, it has been discussed above that the samples are detected/stored/processed (abstract).

Re claim 30, the limitations have been discussed above re claim 3.

Re claim 31, Black teaches logging each sample by a transaction record (paragraph [0125]), and as discussed above.

Re claim 32, the limitations have been discussed above re claim 11.

Re claim 33, the limitations have been discussed above including comparing a first proffered sample with a stored sample (with a cardmember) as during authentication of the card member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 5-7, 9, 14, 23, 25, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above.

Re claims 5-6 and 33 Black teaches (col 6, lines 56+) that the customer record can be stored locally or remotely. Though silent to a datapacket stored on a database, Black teaches the customer record can include biometric information, user information, etc. (FIG. 5A+ for example), which is interpreted as a datapacket. It would have been obvious to store such information on a database, in order to have a well-known and conventional means of storing data for retrieval and organization. It would have been obvious to store the data remotely (or locally) based on security needs, as recognized in the art.

Re claim 7, it has been discussed above that samples are received and stored (database) for providing security/authentication. It would have been obvious to one of ordinary skill in the art that such samples would be received by an authorized sample receiver in order to ensure security and reliability.

Re claim 9, it has been discussed above that a comparison is performed. The Examiner notes that it would have been obvious to one of ordinary skill in the art to use a microprocessor/controller/processor (interpreted as a local CPU) to electronically perform the comparison, in order to have an electronic (automated) means to quickly and reliably perform the comparison, as is conventional in the art.

Re claim 14, as Black teaches that access is only granted when the samples match, it would have been obvious to one of ordinary skill in the art to authenticate the samples upon verification, to control access when only valid samples are received.

Re claim 23, the limitations have been discussed above re claim 6. The Examiner notes that a database is an obvious expedient, and that processing such information contained in at least the transponder/reader/sensor/server/reader system is an obvious expedient to reliably authenticate a user during the attempted transaction.

Re claim 25, the Examiner notes that Black teaches (FIG. 4A) that a registration processor and print processor are used. As discussed above, it would have been obvious to one of ordinary skill in the art to use a local CPU in order to provide an electronic/automated/reliably means to accurately verify a sample, as is conventional in the art (see above). The comparisons have also been discussed above (proffered with a stored).

Re claim 34, the Examiner notes that verifying the sample using information contained on one of a local database/remote database/third party controlled database would have been an obvious expedient in instances where the data is stored remote from the transponder, as discussed above, for security concerns. A remote database provides a preferred means to organize data for efficient and easy storage and retrieval, and is conventional in the art.

Re claim 35, the limitations have been discussed above re claim 9.

8. Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Martizen et al. (US 2002/0191816).

The teachings of Black have been discussed above.

Black is silent to different samples (of the same person) associated with a different one of personal information, credit card information, etc.

Martizen et al. teaches different biometric samples associated with different personal information (different fingers with different accounts) (FIG. 6A).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Martizen et al.

One would have bee motivated to do this in order to permit multiple accounts to be accessed with personalized security.

Though Martizen et al. is drawn towards different fingerprints, the Examiner maintains that it is well known and conventional in the art that different biometrics can be used to control access (voice, fingerprints, retina scans, signatures, etc). Accordingly, the Examiner believes that Martizen can be relied upon for the teachings of different samples to control access, where the type of biometric sample chosen, would have been obvious

to one of ordinary skill in the art, given that there are numerous recognized and interchangeable biometrics that are accepted to control access.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Martizen et al., as discussed above, in view of Moebs et al. (US 2005/0065872).

Re claim 16, the teachings of Black/Martizen et al. have been discussed above.

Martizen et al. teaches a biometric sample is associated with at least one of a first user account, wherein the first account comprises personal information, credit card information, etc. and the first account is different than the second account (different samples), but it silent to primary and secondary associating.

Moebs et al. teaches that a customer can avoid overdraft by preauthorized the institution to tie the customers checking account into the other accounts (paragraph [0017]). The Examiner notes that such protection is well known in the art, and is interpreted to include primary and secondary associating. It would be obvious for the accounts to have the information in order to keep track and identify them.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Martizen et al. with those of Moebs et al.

Additional Remarks

10. The Examiner notes that there are numerous art recognized biometric means of identification (signature, fingerprint, retinal scan, voice print, DNA, etc.). The Examiner believes it is obvious to one of ordinary skill in the art that the teachings of above cited biometric security references in reference to different types of biometrics could be

applied to the specific biometric of signatures, as means to provide biometric security for users. The fact that a reference may disclose a particular type of biometric being used does not preclude such teachings as being non-obvious when used with a different type of biometric, as interpreted by the Examiner.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: McConnell et al. (US 6,148,093), Nakajima et al. (US 2002/0108062), Houvener et al. (US 2002/0138351), Kocher (US 2004/0017934), Haala (US 2005/0005172, 6934861, and 2005/0102524) which teaches recording details in a biometric system when authentication fails, Black (US 2005/0180618 and 6,925,565), Doyle (US 2003/0159044), Teicher et al. (US 6,257,620), McCall et al. (US 20003/0132297) which stores/logs signatures, Kita (US 6,703,918) which teaches a biometric transponder system (FIG. 15+), Rowe (US 2004/0050930) which teaches a DNA smartcard system, Simon (US 2003/0086591) which teaches a DNA card system, and Hoshino (US 6,636,620) which teaches a card based biometric system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
3-16-06